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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/479,979	01/10/2000	WILLIAM HILL	13237-1701/M	3757

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EXAMINER
HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
2178	

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DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/479,979	HILL ET AL.
	Examiner	Art Unit
	Cong-Lac Huynh	2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 June 2004</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
    closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>35-53</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>35-53</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
       application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: appeal brief filed 6/4/04 of

application filed on 01/10/00 which is a continuation of the application 08/847,427 filed

on 4/24/97, now US Pat No. 6,023,714.

2.   Claims 35-53 are pending in the case. Claims 35, 42, and 38 are the

independent claims.

3.   The rejections of claims 35-53 under 35 U.S.C. 103(a) as being unpatentable

over Spyglass Prism in view of Carliner have been withdrawn in view of Applicants

arguments.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103 (c) and potential 35 U.S.C. 102(f) or (g) prior

art under 35 U.S.C. 103(a).

6.   Claims 35-53 are rejected under 35 U.S.C. 103(a) as being unpatentable Guck

(US Pat No. 5,911,776, 6/15/99, filed 12/18/96) in view of DeRose et al. (US Pat No.

5,557,722, 9/17/96, filed 4/7/95).

Regarding independent claim 35, Guck discloses:

- determining a set of capabilities of the output device (**abstract**: the fact that a

    client and a user of the network can access and receive a copy of the original

    source document which is _automatically reformatted to match the requirements_

    of the receiver's appliances indicates that the capabilities of receiver's

    appliances, which are equivalent to the output devices, are determined so that

    reformatting the source document to the format of the receiver's appliances can

    be performed accordingly; **col 4, line 41 to col 5, line 25**: the fact that a user or

    author who creates a single file, can then access multiple ones of the shadow file

    and converter sets in order to provide multiple outputs in a format which can be

    made available to various types of receiving appliances operating on specialized

    formats and communication protocols indicates that the capabilities of the

    receiving appliance, which is equivalent to the output device, are determined

    before sending a document to the appliance)

- selecting one format from multiple available formats based on the set of

    capabilities of the output device (**figure 3, step C**: "author selects one format

from multiple available formats"; **col 16, lines 13-60**:"At step C, the author

selects one format from the multiple number of available formats .. marks *the file*

as shadow file which selects the source file... at step F, the system can display a

list of *available converters based on the source/shadow MIME types* and at step

G, the author or a User can select a particular converter... At step I, *the shadow*

file fetches the content of its source file and then at step J, calls on the

transformation function of its converter, where at step K *the converter transforms*

the input content into an output content ..."; the fact that the format is selected

from a plurality of formats where the transformation of the formats is controlled by

the converter to provide the format of the requester client shows that selecting

one format from multiple available formats based on the capabilities of the output

device is performed)

- formatting the document for presentation on the output device (**abstract**: a client

and a user of the network can access and receive a copy of the original source

document which is *automatically reformatted to match the requirements of the*

receiver's appliances; **col 4, line 66 to col 5, line 24, col 8, lines 1-29**: providing

multiple outputs in a format which can be available to various types of receiving

appliances indicates that the output document is formatted according to the

specified type of the receiving appliance, which is the output device)

Guck does not explicitly disclose that the formats for a document are the style sheets.

DeRose discloses that a style sheet includes format characteristics for type names of elements in a document and a document is also provided with one or more style sheets for specifying format characteristics for its display (col 3, lines 28-50).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined DeRose into Guck for the following reason. DeRose indicates that the format characteristics of the elements in a document are equivalent to the style sheets of the elements in a document providing the advantage to incorporate into Guck to select a style sheet from a plurality of style sheets based upon the capabilities of the output device since selecting the format characteristics is considered equivalent to selecting style sheets.

Regarding claim 36, which is dependent on claim 35, Guck and DeRose do not disclose explicitly that a layout generator is used for determining a set of the capabilities of the output device and selecting one of a plurality of style sheets based upon the set of capabilities of the output device.

However, Guck does teach determining a set of the capabilities of the output device and selecting one format from a plurality of available formats where these formats are suitable to the receiving appliances (as mentioned in claim 35). DeRose discloses that the style sheets includes format characteristics of the elements of a document (as mentioned in claim 35).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined DeRose into Guck since DeRose discloses that the style

sheets are merely the format characteristics of the elements in a document providing

the advantage to incorporate into Guck for selecting a style sheet from a plurality style

sheets based on the capabilities of the output device to format a document according to

the output device.

Regarding claims 37, 44-45, 50, which are dependent on claims 35, 42, 48,

respectively, Guck and DeRose do not disclose that the layout generator is external to

the document.

Instead, Guck discloses that the shadow file and the converter for controlling the format

of the document based on the device of the requester client are separate from the

content of the source file (col 4, lines 40-54, 66 to col 5, line 24, col 8, lines 19-29).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have modified Guck to include the layout generator external to the

document since the fact that the shadow file and the converter for controlling the format

of the output document is _separate from the content file_ suggests that the shadow file

and converter in Guck which are considered equivalent to the layout generator, be

external to the document.

Regarding claims 38-41, 46-47, 49-52, which are dependent on claims 35, 42, 48,

respectively, Guck does not disclose embedding the style sheet in the document,

placing a style tag corresponding to the selected style sheet in the document, wherein

the document includes a plurality of tags and embedding the selected style sheet

comprises placing style attributes corresponding to the selected style sheet in the tags of the document.

DeRose discloses formatting an electronic document by including the style sheets in the markup elements i.e. the tags (col 3, line 57 to col 4, line 11, col 15, line 64 to col 16, line 67).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined DeRose into Guck for the following reason. The fact that DeRose discloses formatting a markup document using style sheets suggests embedding style sheets in the markup tags since it was well known that a markup document is written using tags for including format characteristics to the elements in the markup document. Accordingly, it is suggested that the style sheets selected for the document to be delivered to an output device be embedded in the tags of the markup language document.

Independent claim 42 includes limitations of claim 35, and is rejected under the same rationale except the limitations: selecting a *layout generator* and generating the selected style sheet based upon the set of capabilities of the output device *using the layout generator*.

Guck discloses reformatting the content of the source file into a format that matches the capabilities of the requesting device (col 4, lines 41-54, 66 to col 5, line 24, col 8, lines 19-29, col 16, lines 13-60).

DeRose discloses formatting a markup document using style sheets (col 15, line 64 to col 16, line 59, col 3, line 12 to col 4, line 30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined DeRose into Guck since DeRose discloses that style sheets includes format characteristics for formatting the elements of a document providing the advantage to incorporate into Guck for utilizing the style sheets as format characteristics for reformatting a document to a format that matches the capabilities of receiving appliance which is equivalent to the output device.

Regarding claim 43, which is dependent on claim 42, Guck discloses that the layout generator is a general purpose layout generator for use with a plurality of documents (col 4, lines 40-54, 66 to col 5, line 24: the converter is for reformatting the content of the source file of a plurality of documents according to the request of the client, the converter, thus, is considered equivalent to a layout generator for use with a plurality of documents).

Regarding independent claim 48, the claim includes the limitations as in claims 35 and 42 except interrogating the output device to determine a set of capabilities of the output device. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Guck and DeRose to add interrogating the output device to determine a set of capabilities of the output device since said interrogating is inherently included in "determining a set of capabilities of the output device" which is mentioned in claim 35. The reason is that the system should question the output device to find out the capabilities the output device has.

Regarding claim 53, Guck and DeRose disclose that the document is a markup

language document (Guck: col 6, lines 10-22, col 4, lines 17-31; DeRose: col 3, lines

12-50, col 8, line 39 to col 9, line 20).

Response to Arguments

7.   Applicant's arguments filed 6/4/04 have been fully considered but they are not

persuasive.

Applicants argue that Spyglass and Carliner do not disclose selecting one of a plurality

of style sheets based on the set of capabilities of the output device (Brief, page 6).

Examiner agrees.

Spyglass and Carliner are withdrawn from the rejections.

Guck in combination with DeRose, discloses the argue features in the rejections above.

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Vulpe et al. (US Pat No. 5,787,449, 7/28/98, filed 6/2/94).

Barker et al. (US Pat No. 5,129,052, 7/7/92).

Poole et al. (US Pat No. 6,006,242, 12/21/99, filed 4/5/96).

Microsoft Corporation, Computer Dictionary, Microsoft Press, third edition, page 452.

Borchers et al., Getting It Across Layout Issues for Kiosk Systems, Google, October

1995, pages 68-74.

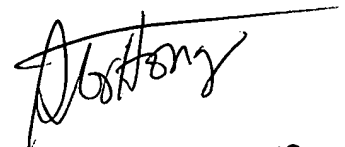Nielsen, Effective Use of Style Sheets, useit.com, July 1997, pages 1-3.

Lie et al., Cascading Style Sheets, Level 1, W3C 12/17/96, pages 1-36.

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Cong-Lac Huynh whose telephone number is 703-305-

0432. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong can be reached on 703-308-5465. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Clh
8/19/04

STEPHEN S. HONG
PRIMARY EXAMINER